

In the United States
COURT OF APPEALS
for the Ninth Circuit

R. W. POINTER, doing business under the fictitious
name and style of Pointer-Willamette Co.,
Appellant,
vs.

SIX WHEEL CORPORATION, a Corporation,
Appellee.

APPELLANT'S REPLY BRIEF

Upon Appeal from the District Court of the United
States for the District of Oregon.

HAROLD L. COOK,
LEE R. SCHERMERHORN,
Cook and Schermerhorn,
717 Corbett Building,
Portland 4, Oregon,
Attorneys for Appellant.

LYON & LYON,
LEWIS E. LYON,
811 West Seventh St.,
Los Angeles 14, Calif.;
GEISLER & GEISLER,
L. R. GEISLER,
Platt Building,
Portland, Oregon,
Attorneys for Appellee.

TABLE OF CASES

	Page
Carlson Hoist and Machine Co. v. Builders Equipment Corp., (C.C.A. 2, 1938) 96 F. (2d) 145; 37 U.S.P.Q. 561	11
Copeman Laboratories Co. v. General Plastics Corp., (C.C.A. 7) 149 F. (2d) 962; 65 U.S.P.Q. 550	4
Gasifier Manufacturing Co. v. General Motors Corp., (C.C.A. 8) 138 F. (2d) 197; 59 U.S.P.Q. 259	3
Gasifier Manufacturing Co. v. Ford Motor Co., (D.C. E.D. Mo., 1939) 43 U.S.P.Q. 377	15
Gelardin v. Revlon Products Corp., et al., (C.C.A. 2) 164 F. (2d) 910, 911; 76 U.S.P.Q. 154, 155	19
I. T. S. Rubber Co. v. Essex Rubber Co., 270 F. 593	15
J. S. Tyree, Chemist, Inc. v. Thymo Borine Laboratory, (C.C.A. 7) 67 U.S.P.Q. 200	4
Kaesar and Blair, Inc. v. Merchants Association, Inc., (C.C.A. 6, 1933) 17 U.S.P.Q. 357, 358	5
Mahn v. Harwood, 112 U.S. 354, 358	5
Mid-Continent Inv. Co. v. Mercoid Corp., 113 F. (2d) 803	4
Minnesota Mining and Manufacturing Co. et al. v. The Carborundum Company et al., (C.C.A. 3, 1946) 155 F. (2d) 746; 69 U.S.P.Q. 288, 291	5, 17
Morley Contr. Co. v. Maryland Cas. Co., 300 U.S. 185, 191	2
Motor Improvements, Inc. v. General Motors Corp., (C.C.A. 6, 1931) 49 F. (2d) 543; 9 U.S.P.Q. 360, certiorari denied 284 U.S. 663	11
Murray v. Noblesville Milling Co., 131 F. (2d) 470	4
Rosemary Mfg. Co. v. Halifax Cotton Mills, Inc., (C.C.A. 4, 1919) 257 F. 231	11

TABLE OF CASES (Cont.)

	Page
Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 330; 65 U.S.P.Q. 297, 299	18
Six Wheel Corp. v. Sterling Motor Co. of California, 40 F. (2d) 311	12
Smith, Kline and French Laboratories v. Clark & Clark, (C.C.A. 3) 70 U.S.P.Q. 382	3
Smith v. Snow, 294 U.S. 1, 11	10
Universal Oil Products Co. v. Globe Oil and Refining Co., 322 U.S. 471 (1944)	10
United States v. Anderson Co., 119 F. (2d) 343	4
Walker on Patents, (Deller's Edition)	4, 5

In the United States
COURT OF APPEALS
for the Ninth Circuit

R. W. POINTER, doing business under the fictitious
name and style of Pointer-Willamette Co.,
Appellant,
vs.

SIX WHEEL CORPORATION, a Corporation,
Appellee.

APPELLANT'S REPLY BRIEF

Upon Appeal from the District Court of the United
States for the District of Oregon.

Plaintiff-appellee has repeatedly throughout its brief set forth the proposition that the questions of novelty, invention and infringement are questions of fact, and that these findings are supported by substantial evidence and should not be disturbed. Appellee overlooks two facts which constitute the basis of, and the relief sought, by appellant on this appeal, as follows: (1) The findings of fact are against the weight of the evidence, and (2) plaintiff's patent was not properly construed with reference to the prior art.

The findings of fact by the court may be set aside when clearly erroneous. (See Comments in Edmunds

Federal Rules of Civil Procedure, Pages 1275-1316; Simkins Fed. Practice, 3rd Ed., Sec. 523.)

Rule 52b of the Federal Rules of Civil Procedure provides:

“When findings of fact are made in actions tried by the court without a jury, the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question has made in the district court an objection to such findings or has made a motion to amend them or a motion for judgment.”

In Simkins, 3rd Ed., Sec. 647, it is said there is no requirement that the findings must be excepted to in order to lay a foundation for review on appeal. See also Sec. 648, and in Simkins, 3rd Ed., pages 487-8, after stating the rule that when findings of fact are made in actions tried by the court without a jury the question of the sufficiency of the evidence to support the findings may thereafter be raised whether or not the party raising the question has made in the district court an objection to such findings, and after stating this to be one of the most striking changes made in the new rules over the former practice, it is said that under the new practice, where findings are made by the court without a jury, the appellate court is not limited to the mere question of whether there is any substantial evidence to support them, but may set them aside if against the clear weight of the evidence, at the same time giving full effect to the qualification of the trial judge to pass on credibility. See in accord *Morley Contr. Co. vs. Maryland Cas. Co.*, 300 U.S. 185, 191.

"A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed." *United States vs. U. S. Gypsum Co. et al.*, (U.S. Sup. Ct.) 333 U.S. 364; 71 U.S.P.Q. 430.

In *Gasifier Manufacturing Co. vs. General Motors Corp.*, (C.C.A. 8) 138 F. (2d) 197; 59 U.S.P.Q. 259, Circuit Judge Sanborn of the Eighth Circuit Court of Appeals made the following statement of law as to the findings of the district Court:

"In a jury-waived case, the court is the trier of fact questions, and its determination of them, 'unless clearly erroneous,' is as conclusive upon review as is the verdict of a jury.

"A finding of fact of a district court is not clearly erroneous unless it is (1) unsupported by substantial evidence, (2) contrary to the clear weight of the evidence, or (3) induced by an erroneous view of the law. *Aetna Life Ins. Co. v. Kepler*, 8 Cir., 116 F. 2d 1, 4-5; *Kauk v. Anderson*, 8 Cir., 137 F. 2d 331, 333."

The question of what constitutes anticipation is one of law, as open for determination by the appellate court as by the district court. *Smith Kline and French Laboratories v. Clark & Clark*, (C.C.A. 3) 70 U.S.P.Q. 382. In the instant case there are few, if any, of the essential or controlling facts in dispute. Whatever dispute exists has to do with the conclusions drawn from the facts. The question, therefore, is whether the court's conclusions are correct. True it is, the trial court has the primary function of weighing the evidence and finding the facts, and appellant is bound by the findings if they are

supported by the evidence. The rule, however, does not operate to entrench with like finality, the ultimate fact conclusions drawn therefrom. *United States v. Anderson Co.*, 119 F. (2d) 343; *Murray v. Noblesville Milling Co.*, 131 F. (2d) 470; *Mid-Continent Inv. Co. v. Mercoid Corp.*, 113 F. (2d) 803; *J. S. Tyree, Chemist, Inc. v. Thymo Borene Laboratory*, (C.C.A. 7) 67 U.S.P.Q. 200.

In *Copeman Laboratories Co. v. General Plastics Corp.*, (C.C.A. 7) 149 F. (2d) 962, 65 U.S.P.Q. 550, in a patent infringement suit defendant relied upon the prior art as being anticipatory and also showing want of invention. Circuit Judge Major said:

“The lower court treated it as analogous, and we are of the view that the issue raised on this appeal depends in the main on the court’s finding in this respect. The sole testimony on the subject was that of an expert witness who expressed the opinion that it was non-analogous. The question must be determined from an examination of the prior art itself. Under such circumstances, we think we are free to reach a conclusion as to its applicability.”

Walker on Patents, Deller’s Edition, Sec. 749, reads as follows:

“If the finding of the judge be a special one, it will be conclusive on the facts found; but ‘the sufficiency of the facts found to support the judgment’ will be open to review in the Circuit Court of Appeals.” Citing cases.

It is well settled law that the construction of patents involves a question of law, and is therefore a matter for the trial judge to determine in the first instance, and is subject to review by the appellate court on appeal. The

leading authority on patent law, Walker, (Deller's Edition) pages 1209-1210 states: "Since letters patent are contracts, questions of construction are questions of law for the judge, not questions of fact for the jury." And again on page 1907, Walker states: "Construction of patents is a point of law."

It has been held by the United States Supreme Court in *Mahn v. Harwood*, 112 U.S. 354, 358, that whether the thing patented amounts to a patentable invention is a question of law to be decided by the courts.

Judge Biggs of the Third Circuit Court of Appeals in the case of *Minnesota Mining and Manufacturing Co. et al. v. The Carborundum Company et al.*, (C.C.A. 3, 1946) 155 F. (2d) 746; 69 U.S.P.Q. 289, 291, stated:

"But quite apart from the foregoing the words of a patent or a patent application, like the words of specific claims therein, always raise a question of law for the court and may not be determined by the opinion of experts. *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30; *Solomon v. Renstrom*, (C.C.A. 8) 150 F. 2d 805, 807."

Much of the evidence in the case at bar is in the form of exhibits, particularly the prior art patents. These exhibits must necessarily have been construed by the District Court. The decision in *Kaeser and Blair, Inc. v. Merchants Association, Inc.*, (C.C.A. 6, 1933) 17 U.S. P.Q. 357, 358, is applicable.

"The finding of unfair competition was based upon exhibits introduced in evidence. This court [Circuit Court] therefore cannot give to the finding the weight that attaches to a finding of fact where the court [District Court] has heard witnesses in

open court, but must draw its own deductions and conclusions from an examination of the exhibits.”

Accordingly, the prior art patents introduced as evidence and designated for the record on appeal are the proper subjects of review by the Court of Appeals in determining whether or not the Honorable District Court properly construed the claims in determining the issues of infringement and the validity of the claims.

Prior Art Patents

The appellee seeks to nullify the effect of the prior art—first by saying that appellant has abandoned its position before the District Court with respect to these prior patents; and second that the prior art discloses structures which are impractical and inoperative.

The patents relied upon by defendant to anticipate or limit the claims of the letters patent in suit are, in the order of their presentation to defendant’s expert witness, as follows:

	British, No. 8262 of 1906	Defendant’s exhibit	59
*Spencer			
*Smith	1,111,924	“	“ 38
*Collard	1,131,118	“	“ 39
*Laisne	1,316,369	“	“ 45
*McCracken	1,527,987	“	“ 50
*Mohl	1,534,458	“	“ 51
*Richards	177,156	“	“ 31
*Jeffries	174,533	“	“ 30
*Pratt	878,156	“	“ 32
*Brillie	915,733	“	“ 35
*Pichoud	1,147,439	“	“ 40
Parks	1,239,211	“	“ 41
*Furlong	1,436,031	“	“ 48
*Stebbins, et al.	1,562,265	“	“ 52

*Van Leuven	1,655,481	"	"	56
*Fageol	1,692,891	"	"	58
Gros	British, No. 18,943	"	"	60
Baines	British, No. 214,080	"	"	62
Janvier	German, No. 209,994	"	"	66

IN EACH AND EVERY INSTANCE DEFENDANT'S EXPERT WITNESS SHOWED HOW THE CLAIMS OF THE KNOX PATENT IN SUIT ARE READABLE ON THE STRUCTURES OF THESE SEVERAL PRIOR ART PATENTS. Appellant has not abandoned the position indisputably established by its expert witness in this regard. The patents marked with an asterisk (*) are those relied upon by appellant on this appeal.

On cross examination Dr. Clark admitted that the structures disclosed by *three* of these patents were impractical. These were the structures of British Patent 18,943 to Gros, British Patent 214,080 to Baines, and German Patent 209,994 to Janvier. Dr. Clark said: "I doubt whether it [the structure of British Patent 18,943] would work out to be practical." (R. 254). Of the German patent Dr. Clark merely said: "I would not care to own a vehicle like that." (R. 252). Dr. Clark stated that the structure of British patent 214,080 would not be practical on a four wheel vehicle. (R. 259). Summarizing Dr. Clark's statements regarding these three prior art patents: one is impractical; he would not care to own another; and another would be impractical on a four wheel vehicle. These are but *three* out of 39 patents, and no one of these three are among those relied upon by appellant on appeal. Moreover, NO TESTIMONY

WAS OFFERED THAT THESE STRUCTURES WERE INOPERABLE. How then can the District Court say that the prior art patents relied upon by the defendant to anticipate or limit the claims of the letters patent in suit are, as established through defendant's expert, Dr. Clark, either impracticable or inoperative? It is submitted that finding of fact No. 20 is clearly erroneous.

Appellee says that appellant does not now rely upon patents chosen by its expert witness to be the "best" of the 39 patents listed in its pleading, and therefore has abandoned the position of its own expert before the District Court with respect to these prior patents. An examination of the record does not clearly reveal just what was the "position of defendant's expert before the district court". Dr. Clark had read claims 1, 2, 11, 15 and 17 of the patent in suit on the disclosures of the patents hereinbefore listed. On cross examination, plaintiff's counsel asked these questions:

"Which of the patents which you have testified concerning do you consider as being close in *showing the disclosure* of the Knox patent?" (R. 234).

"Take the *structure* as disclosed in the *drawings* of the Knox Patent * * *." (R. 234).

"Which of the patents do you consider to be close to showing the elements of the Knox patent, as shown in the drawings?" (R. 235).

The witness complained: "I don't know what you mean by close in reference." which elicited the question:

"Close in reference *as shown in the drawing* of the Knox patent and as described in the specifications?"

The witness demurred when asked to pick out the prior art patents which he considered as closest to the structure. He said: "I can't do that now * * * because you haven't defined what you mean by 'structure'. Is it appearance, elements and, if not, why not put your question in the form as to which one meets the claims, and then I will tell you, because I have that information here." (R. 237).

Thereupon plaintiff's counsel asked:

"Which one of the patents do you consider the closest to the structure, having the mode of operation and the structure as defined in the specification and drawings of the Knox patent, the patent in suit?" (R. 238). And again:

"Now, will you simply pick out what you consider to be the best patent with relation to *the form of the invention* shown on page 1 of the Knox patent in suit, and I mean the best." When the witness said that there is none that corresponds in detail to that shown in the Knox patent, then plaintiff's attorney countered with the question: "In structure, function and mode of operation?" To which defendant's witness refused to agree. (R. 247-248).

All in all the cross examination of defendant's expert witness was a highly successful attempt to confuse the witness, the court and even defendant's counsel. When defendant's counsel asked to be enlightened as to

whether plaintiff's questions related to mode of operation, or structure, or function he was told, in effect, to mind his own business. The cross examination of defendant's witness was highly irrelevant and immaterial and was not helpful to either the District Court or the Court of Appeals in ascertaining which is the "best" of the prior art patents. "Best" in what respect? Certainly, not as being anticipatory of the structure defined by the claims in suit.

Appellee persuaded the District Court that since the prior art patents cited by appellant do not *look like* the device illustrated in the drawings of the Knox patent, they cannot possibly anticipate structure defined by the claims of the patent in suit. The purpose of the prior art patents relied upon by appellant is to show structures *defined by the claims* of the patent in suit; and it is immaterial that the prior art devices do or do not resemble the structure shown in Knox's drawings. The cross examination of defendant's expert witness was intended to point out how Knox's device differed in appearance from the prior art structures, but Knox did not limit his claims to so distinguish from the prior art. It is the claims that measure the invention—not the drawings. *Smith v. Snow*, 294 U.S. 1, 11, cited with approval in *Universal Oil Products Co. v. Globe Oil and Refining Co.*, 322 U.S. 471 (1944). If Knox made a patentable invention, he failed to define it, either deliberately or inadvertently, in terms which avoid the prior art. Appellee's concept of prior art apparently is different from the accepted concept of the courts. Appellee seems to think that to be prior art, there must be a successful,

working, operative structure, identical to the device for which patent is applied. Such a concept takes no cognizance of the teaching of prior art patents unless they are in identical form to the device of the patent. This is not the law.

Even an inoperative reference may be considered by the court for whatever idea it discloses. *Rosemary Mfg. Co. v. Halifax Cotton Mills, Inc.*, (C.C.A. 4, 1919) 257 F. 231. Though the reference device be inoperative as a whole, it may be anticipatory as to that portion which is operative. *Motor Improvements, Inc. v. General Motors Corp.*, (C.C.A. 6, 1931) 49 F. (2d) 543; 9 U.S. P.Q. 360; certiorari denied 284 U.S. 663. And if the skill of the artisan would make the reference instrumentality operative, it may be effective as an anticipation. *Carlson Hoist and Machine Co. v. Builders Equipment Corp.*, (C.C.A. 2, 1938) 96 F. (2d) 145; 37 U.S.P.Q. 561.

The United States Patent Office is a treasure house of ideas, and to be patentable, the device must be defined in terms which do not read on these disclosures. There is no need to make inquiry as to whether the prior patented device was ever used, or as to what success attended the use. Its disclosure speaks for itself. Its success or failure depends on factors, such as its timeliness and the promotional effort placed behind it. One does not see on the road today structures which resemble the Knox drawings. In fact, the structure shown in Figure 1 of the Knox patent was abandoned within six months of its first reduction to practice (R. 90); and the use of the structure shown in Figures 6, 7 and 8 was discontinued in 1927 or 1928 (R. 104), before the patent

issued. The type of suspension used on trailers currently manufactured by plaintiff-appellee is similar to that shown in Stebbins et al. patent 1,562,265. (R. 105).

Obviously, the "best" prior art patent, insofar as constituting an anticipation of the structure defined by the Knox claims in suit is concerned, is the patent to Van Leuven, 1,655,481. Appellee says that Van Leuven shows a rigid type structure, and that Van Leuven believed it necessary to steer the added non-driven wheels.

The Van Leuven patent was owned by appellee (R. 120), and up to the date of expiration of the term of the patent appellee brought suit under both the Van Leuven patent and the Knox patent. *Six Wheel Corp. v. Sterling Motor Co. of California*, 40 F. (2d) 311.

The Van Leuven patent was involved in interference No. 55,455 involving also an application by Harry Y. Stebbins covering the structure disclosed in Figure I of the Knox patent in suit, except that he did not provide a *universal joint* between the rocker arm and the axle of the attachment. Priority of invention was awarded to Van Leuven, and it will be noted that claims 10 and 12 of Van Leuven read upon the structure of the Knox patent. In Van Leuven the rocker arm takes the form of a leaf spring 29. It will be remembered that Mr. Knox testified that a leaf spring is the equivalent of a universal joint (R. 113); and that transverse tilting of the axle is taken by the springs. In this, Knox is in agreement with the statement appearing on page 3, lines 72-77 of the Van Leuven patent, which reads:

"If the up and down motion of the auxiliary wheels 43 is excessive, owing to extreme irregularities in the road surface, such motion will be taken care of by turning of the springs 29 about the fulcrum point of said springs, namely, the studs 34."

Van Leuven's claims 10 and 12 recite that the levers (springs 29) are mounted for independent equalization on opposite sides of the frame. There could be no independent equalization of these springs except that the axle 41 of the attachment could assume a position of irregularity or angle to the driven axle. In fact the Van Leuven structure more nearly conforms to the definition of the Knox claims in suit that does the structure shown by Knox's drawing, for the reason: In the Knox structure the rocker arms are rigid beams, and are connected to the axle of the attachment by steel bearings, and both axles 2 and 10 are maintained in spaced relation by radius arms 32 and 21 of invariable length; whereas in Van Leuven, due to the flexible beam 29, the axle 41 does not have vertical movement only, but may approach toward or move away from the driven axle, as clearly illustrated in Figure 9 of the drawings.

The mechanism provided by Van Leuven for steering the added wheels in no wise detracts from or interferes with distribution of the load to the added wheels of the six wheel attachment.

Appellee offers no criticism of the structure of Stebbins Patent No. 1,562,265 other than that Stebbins had provided means for steering the wheels of the added axle. It is undisputed that the Stebbins structure functions to equalize the load between the intermediate carrier

wheels and the driven wheels, and all of the testimony as to the impracticability or inoperability of the Maxi type structures because of the steerability of the added wheels is wholly irrelevant and immaterial to the present issue. That this is true is shown by the testimony of Mr. Knox who stated that the type of suspension used on trailers currently manufactured by appellee is the structure shown in the Stebbins patent, except that no means is provided for steering the wheels of the added axle, and that the springs are journaled on the axles. It is clear therefore that appellee's attack on these prior art patents on grounds of impracticability and inoperability fails for lack of materiality to the issues of the instant case, and there is no testimony in the record to substantiate finding of fact No. 20, which says:

"That the prior [art] patents relied upon by defendant * * * are * * * either impractical or inoperative, * * *."

Infringement

The question of infringement, in the case at bar, is a matter of law, because the evidence concerning infringement is undisputed. Plaintiff submitted no evidence of infringement other than as to identity of the alleged infringing device and the manufacture and sale thereof by the defendant, and defendant's evidence was directed toward the validity of the patent in view of the prior art patents. The nature and identity of the alleged infringing device is undisputed, and a full description including a model is before the court. The issue to be

decided was, therefore, one of construction of the Knox patent as to whether or not the claims in suit read upon the alleged infringing device, and if they so read, whether they also read, construed in like manner, upon prior art patents. See *I. T. S. Rubber Co. v. Essex Rubber Co.*, 270 F. 593, wherein the court stated at page 598: "Upon undisputed evidence infringement or non-infringement is a question of law. *Singer Co. v. Cramer*, 192 U.S. 265, 275; *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30, 36."

The situation here is one in which the plaintiff offered no evidence of infringement other than the undisputed evidence concerning identity of the alleged infringing structure and the fact of manufacture and sale by the defendant, which is admitted. The defendant offered evidence that the claims were invalid as reading on the prior art, *which was not refuted by the plaintiff*. Notwithstanding this state of the evidence, the judge made findings of fact in favor of the plaintiff, and we have the anomalous situation of a plaintiff receiving a judgment when it did not establish a case, and when the defendant established a preponderance of evidence showing invalidity of the claims in suit.

The case at bar is not substantially different from the case of *Gasifier Manufacturing Co. v. Ford Motor Co.*, (D.C. E.D. Mo., 1939) 43 U.S.P.Q. 377, wherein Judge Collet in ruling on a motion for summary judgment summarized questions of law and fact involved in that case in the following language:

"But, in order to submit an issue of fact to the jury there must be an issue of fact existing, and if all

those facts are admitted—if the patent and its operation is admitted, as it is, if the infringing device is before the court as it is, and its operation is not disputed, as is the case in this instance, then when the evidence is all in it will be my duty to apply the law of equivalents and say to the jury that under all of these conceded facts the application of the law results in this device being placed in the classification of a similar device, or, that it is placed in the classification of one that is not similar. I must answer that question as a question of law before I submit the case to the jury, and if I have all those facts before me now, I must determine that question now. The question therefore resolves itself into a question of law as to whether, applying the law of equivalents, with all the facts admitted, which under the law of equivalents this assailed device or accused device, however it may be referred to, is a similar device.”

Although the case at bar was not disposed of on summary judgment, and although there was no jury, the situation is almost identical to that described by Judge Collet. There was no dispute as to the nature and the operation of the infringing device. The question is whether the claims of the Knox patent are valid, and whether those claims read on the alleged infringing device. These questions cannot be resolved without a construction of the claims and the Knox patent in general. It is in this respect that the District Court committed error, and these are the questions, questions of law, that appellant asks the Honorable Court of Appeals to review.

Appellant maintains that the District Court did not properly construe the claims of the Knox patent, for

when these claims are construed so broadly as to find infringement of the Knox patent by the Feather Ride structure, then those claims read on the prior art, and are therefore invalid. This is the issue which appellant asks the Honorable Court of Appeals to decide, and appellant submits that it is a question of law, and not one of fact.

It is also well settled law that the claims may not be construed so broadly, by the doctrine of equivalents, in order to read on the alleged infringing device, that they also read on the prior art, and if so construed, the claims are invalid. That, appellant contends, is exactly and precisely the situation in the case at bar, and constitutes the error made by the District Court.

Circuit Judge Biggs of the Third Circuit Court of Appeals in the case of *Minnesota Mining and Manufacturing Co. et al. v. The Carborundum Co. et al.*, (1946) 155 F. (2d) 746; 69 U.S.P.Q. 289, 291, stated: "But quite apart from the foregoing the words of a patent or a patent application, like the words of specific claims therein, always raise a question of law for the court and may not be determined by the opinion of experts. *Sanitary Refrigerator Co. v. Winters*, 280 U.S. 30; *Solomon v. Renstrom*, (C.C.A. 8) 150 F. (2d) 805, 807." With this pronouncement of the law plaintiff's attorney seemed to be in agreement. He said:

"Mr. Cook: Are you willing that these copies speak for themselves?

"Mr. Lyon: Certainly. The testimony won't add anything to them." (R. 213).

Stebbins and Knox Are Joint Inventors

In January, 1925, Stebbins brought to Utility Trailer Manufacturing Company a six wheel attachment. Knox suggested the need for more flexibility in the attachment. Stebbins "agreed that some universal action would be an improvement." Stebbins' salesman, Clune, made sketches of a form of universal joint which could be incorporated in the six wheel attachment Stebbins had in production. Tracings were made by Stebbins' draftsman. These sketches were earlier than Knox drawings B. C. and D. Knox's only contribution was to recommend a universal joint of a different form than that submitted by Stebbins. A universal joint was not employed until Utility Trailer Company took over the manufacture and sale of the attachment under license from Stebbins, as Mr. Knox "was not positive that the Stebbins construction might not stand up sufficiently well to be satisfactory, and so did not insist on complicating the mechanism until his type had been put into service." (p. 71, Inf. 55, 383). Stebbins and Knox are joint inventors.

Knox Structure Did Not Involve Patentable Knowledge or Invention

The courts have repeatedly held that before a valid patent may issue it must appear that the new device, however useful it may be, must reveal not merely the skill of the art. There must be an innovation for which society is truly indebted to the efforts of the patentee. *Sinclair & Carroll Co. vs. Interchemical Corp.*, 325 U.S. 327, 330; 65 U.S.P.Q. 297, 299. And while it is true that

the act of putting together old elements which gives them an added value may entitle one to claim "Invention", the combination must be one for which exceptional imaginative talent was necessary. *Gelardin vs. Revlon Products Corp.*, (C.C.A. 2) 164 F. (2d) 910, 911; 76 U.S.P.Q. 154, 155.

* * * * *

It is respectfully submitted that the decree of the District Court is clearly erroneous and should be reversed.

Respectfully submitted,

HAROLD L. COOK,

LEE R. SCHERMERHORN,

Attorneys for Appellant.

